

**REMARKS**

Claims 1-31 remain pending in the application.

The Applicants respectfully request the Examiner to reconsider earlier rejections in light of the following remarks. No new issues are raised nor is further search required as a result of the changes made herein. Entry of the Amendment is respectfully requested.

**Finality of the Office Action**

The Office Action is indicated as being Final. The Finality of the Office Action is improper since failing to address all of the Applicants' arguments. The Applicants argued against McDowell as being improperly applied against the claims since 35 U.S.C. §102(e) requires the cited prior art to be "an application for patent". A provisional application is **NOT** an application for patent as required by the statute. Therefore, McDowell is does not quality as prior art under 35 U.S.C. §102(e). The Applicants respectfully request that the Finality of the Office Action be withdrawn.

**Claims 1-16, 20-25 and 29-31 over Mcdowell**

In the Office Action, claims 1-16, 20-25 and 29-31 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by McDowell et al., U.S. Patent Application Publication US2001/0034224 A1 ("McDowell"). The Applicants respectfully traverse the rejection.

The Examiner alleges that since McDowell claims priority to the provisional application no. 06/178,142, filed on January 26, 2000, it is determined that McDowell has privilege to the earlier provisional filing date of January 26, 2000 (Office Action, page 14). The Applicants respectfully agree and disagree.

Although a patent application can claim priority to a provisional application, the patent application only has priority to matter that is disclosed in the provisional application. A later filed patent application that failed to have support for disclosed matter in the provisional application therefore only disclosed such matter at the time of filing the patent application.

For example, a patent is filed and the Applicant later decides to add additional matter to the disclosure. The disclosure is rejected for new matter because if the new matter was allowed to remain it would get the benefit of the earlier filing date. The same is true of a patent application based on a provisional application. Matter not disclosed until a later time can not get the benefit of an earlier filing date.

McDowell is a publication of a patent application filed on January 26, 2001, which is its relevant 35 U.S.C. §102(e) date. This does not predate the filing date of the present application. The provisional application filing date, January 26, 2000, that the Examiner has apparently underlined can not be relied on since the degree of disclosure on that date is unknown. The publication of the later filed McDowell application is not prior art with respect to the claims of the present application. The Applicants respectfully request a copy of the provision application McDowell is based on to access the degree of disclosure on January 26, 2000.

Moreover, 35 U.S.C. §102(e) requires the cited prior art to be "an application for patent". A provisional application is **NOT** an application for patent as required by the statute. Therefore, McDowell is does not quality as prior art under 35 U.S.C. §102(e).

Accordingly, the rejection of claims 1-16, 20-25 and 29-31 is improper over the McDowell Application Publication cited. It is therefore respectfully requested that the rejection be withdrawn.

#### **Claims 17-19 and 26-28 over McDowell in view of Sandegren**

In the Office Action, claims 17-19 and 26-28 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over McDowell in view of Sandegren, U.S. Patent No. 6,512,930 ("Sandegren"). The Applicants respectfully traverse the rejection.

As discussed above, McDowell is not prior art with respect to the claims of the present application. The rejection on its face cannot stand on Sandegren alone.

Accordingly, the rejection of claims 17-19 and 26-28 is improper over the McDowell cited. It is therefore respectfully requested that the rejection be withdrawn.

**Comments for McDowell and Sandegren**

Claims 1-31 recite an apparatus and method that forwards a registration notification message and an MSInactivity message received over a TCP/IP connection.

McDowell appears to disclose a system and method for sharing user event information such as presence information on a network among mobile devices and those connected to fixed IP networks such as the Internet (Abstract). When a mobile device is turned on, the mobile device informs a mobile event server (MES) of the presence on the network and the MES broadcasts the presence to appropriate services and users (McDowell, 0034). A mobile service center (MSC) connected to an SS7 network sends SS7 messages to a home location register (HLR), the HLR connects to the MES (McDowell, 0056-0057; Fig. 10a). The MES informs a chat server that a cellular phone user is online (McDowell, 0030). In an alternate embodiment, an SS7 link is used to connect the MES and a service transfer point (STP) for detection of mobile device activity (McDowell, Fig. 6a and 6b).

McDowell mentions TCP/IP once in paragraph 0046. However, McDowell discloses a HLR that can forward a REGNOT message to another device over a TCP/IP link.

McDowell discloses sending an MES notification of when a mobile device is turned on. The MES forwards the notification to a chat server. The MES receives notification messages over an SS7 link. McDowell fails to disclose a method and apparatus that forwards a registration notification message and an MSInactivity message received over a TCP/IP connection, as recited by claims 1-31.

Sandegren appears to disclose a system that notified a first user of a mobile communication device about status of other users in a mobile

communications system (Abstract). A user can establish a list of individuals whose status is of interest to him (Sandegren, col. 3, lines 1-3). The list of individuals may be recipients of a call, a data transmission, or any other type of communication from a user (Sandegren, col. 3, lines 3-6).

Sandegren discloses all of the messages within the system are sent to components within the wireless system. Sandegren fails to disclose or suggest forwarding any type of messages outside of the wireless system over an Internet connection, much less disclose or suggest a method and apparatus that forwards a registration notification message and an MSInactivity message received over a TCP/IP connection, as recited by claims 1-31.

A benefit of forwarding a registration notification message and an MSInactivity message received over a TCP/IP connection, e.g., is portability. The cited prior art requires an SS7 link to connect the MES that receives notification messages. An SS7 link requires the MES to be connected to the telephone network. A TCP/IP connection allows a message receiver to be connected to any TCP/IP compatible connection, possibly nowhere near the telephone network being monitored. This gives the advantage of portability. The cited prior art fails to disclose or suggest a method and apparatus that has such benefits.

**Conclusion**

All objections and rejections having been addressed, it is respectfully submitted that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,  
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